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April 21, 2004

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Art Unit 1761

Commissioner for Patents PO Box 1450 Alexandria, VA 22313-1450

Re:

U.S. Divisional Utility Patent Application

Application No. 10/055,430; Filed: January 25, 2002

For: Malt Beverage Having Stabilized Flavor and Methods of Production

**Thereof** 

Inventors:

RANGEL-ALDAO et al.

Our Ref:

1390.0070006/JAG/BJD

Sir:

Transmitted herewith for appropriate action are the following documents:

- 1. Reply to Requirement for Election of Species; and
- 2. One (1) return postcard.

It is respectfully requested that the attached postcard be stamped with the date of filing of these documents, and that it be returned to our courier. In the event that extensions of time are necessary to prevent abandonment of this patent application, then such extensions of time are hereby petitioned.

Commissioner for Patents April 21, 2004 Page 2

The U.S. Patent and Trademark Office is hereby authorized to charge any fee deficiency, or credit any overpayment, to our Deposit Account No. 19-0036.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.

Brian J. Del Buono Attorney for Applicants Registration No. 42,473

BJD/nef Enclosure

255573\_1.DOC



## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Rangel-Aldao et al.

Appl. No. 10/055,430

Filed: January 25, 2002

For: Malt Beverage Having Stabilized Flavor and Methods of Production

Thereof

Confirmation No.: 7557

Art Unit:

1761

Examiner:

Sherrer, C.

Atty. Docket: 1390.0070006/JAG/BJD

## Reply to Requirement for Election of Species

Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450

Sir:

In reply to the Office Action dated March 23, 2004, requesting an election of species to prosecute in the above-referenced patent application, Applicants hereby provisionally elect (1) contacting the inhibiting agent with a beer; and (2) aminoguanidine as the inhibiting agent. Claims 46, 49-51, 53 and 54 read on the elected species. This election is made without prejudice to or disclaimer of the other claims or inventions disclosed. Applicants reserve the right to have additional species considered in the event that a generic claim is found to be allowable in accordance with 37 C.F.R. § 1.141(a).

This election is made with traverse. In the Office Action at page 2, the Examiner states that the claims are directed to patentably distinct species. However, even where patentably distinct inventions appear in a single application, restriction remains improper unless the Examiner can show that the search and examination of the different species would entail a "serious burden." See MPEP § 803. In the present situation, the Examiner has failed to make such a showing. Accordingly, Applicants respectfully assert that the requirement for election of a single disclosed species is improper and should be withdrawn.

Applicants also note that, notwithstanding the impropriety of the election of species requirement, one of the species apparently has been misidentified in the Office Action. Specifically, at page 2, the Examiner states that "applicants must elect from contacting the inhibiting agent with a) a malt; b)a wort or c)a beer." Applicants note that independent claims 47 and 48 are drawn to methods comprising contacting a wort (claim 47) or a grain malt (claim 48) with at least one inhibiting agent. However, Applicants further note that independent claim 49 is drawn not to contacting a beer with at least one inhibiting agent, as the Examiner has apparently presumed in establishing the species for election in the present Office Action. Instead, independent claim 49 is drawn to methods comprising contacting a fermented malt beverage with at least one inhibiting agent. As the present specification clearly indicates (see, e.g., Specification at page 18, lines 13-14), the term "fermented malt beverage" is not limited to a beer, but encompasses any malt-flavored beverage produced by fermentation. Hence, "a beer" is more properly considered a subspecies of the alleged species "fermented malt beverage." To this end, Applicants note that the subspecies "a beer" is not recited in any of the currently pending claims except for claim 54, which depends in part from independent claim 49 that recites "a fermented malt beverage." Accordingly, Applicants respectfully contend that, if an election of species was proper in the present case, the correct third species in the first group identified by the Examiner should be "a fermented malt beverage" instead of the subspecies "a beer." Thus, if the Examiner is not inclined to reconsider and withdraw the Election of Species requirement as a whole, then Applicants respectfully request that it be reconsidered in part and that the correct species, namely "a

fermented malt beverage," be substituted in place of the subspecies "beer," both in the Office Action and in the above-noted election of species.

In view of the foregoing remarks, Applicants respectfully contend that the election of species requirement is improper in whole or in part. Reconsideration and withdrawal of the Requirement for Election of Species, and consideration and allowance of all pending claims, therefore are respectfully requested.

It is not believed that extensions of time are required beyond those that may otherwise be provided for accompanying documents. However, if additional extensions of time are necessary to prevent abandonment of this application, then such extensions of time are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor are hereby authorized to be charged to our Deposit Account No. 19-0036.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.

Brian J. Del Buono Attorney for Applicants Registration No. 42,473

Date: April 21,2004

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